

REMARKS

Claims 28, 30-35, 39-42, and 44-49 are pending. Claim 39 is rejected under 35 U.S.C. § 102(e). Claims 28, 30-31-34 and 42-48 are rejected under 35 U.S.C. § 103(a). Group I claims 1-27 and 36-38 have been canceled.

Independent claim 39 is rejected under 35 U.S.C. § 102(e) as being anticipated by Whinnett et al. Claim 39 recites "A circuit, comprising an encoder circuit coupled to receive a plurality of symbols, the encoder circuit producing the plurality of symbols and a sequence of predetermined signals at a first and a second output terminal, wherein the sequence of predetermined signals comprises a code sequence, and wherein **a first shift of the code sequence corresponds to the first output terminal and a second shift of the code sequence corresponds to the second output terminal.**" (emphasis added). This feature of the present invention is described in detail at paragraph 34 with reference to Figure 5B.

As best applicants understand the present rejection (col. 5, lines 28-35), Examiner takes first and second levels of error correction coding as first and second shifts of the code sequence of claim 39. This is incorrect. Claim 39 recites a single code sequence. One part of the code sequence (first shift) corresponds to a first output terminal. Another part of the code sequence (second shift) corresponds to a second output terminal. Both are parts of the same code sequence. This is very different from the disclosure of Whinnett et al.

Examiner mistakenly states "[o]perations are being done on one code sequence $S_1S_2S_3S_4$." Regarding Figure 5 of Whinnett et al., however, symbols $S_1S_2S_3S_4$ are not a code sequence. They are data symbols. Whinnett et al. specifically state "[a]s shown, data source 20 provides a **data stream of symbols**, which may be encoded and interleaved." (emphasis added) (col. 5, lines 12-14). Whinnett et al. do not disclose first and second shifts of a code sequence. Moreover, Whinnett et al. do not disclose that a first shift of a code sequence corresponds to a first output terminal and

that a second shift of a code sequence corresponds to a second output terminal as required by claim 39. Thus, claim 39 is patentable under 35 U.S.C. § 102(e) over Whinnett et al.

Independent claims 28 and 40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Whinnett et al. (U.S. Pat. No. 6,317,411) in view of Secord et al. (U.S. Pat. No. 6,373,831). Claim 28 recites “the encoder circuit coupled to receive a control signal, the encoder circuit producing the plurality of symbols at the first output terminal and the transform of the plurality of symbols at the second output terminal in response to a first value of the control signal, the encoder circuit producing the plurality of symbols at the first output terminal and not producing the transform of the plurality of symbols at the second output terminal in response to a second value of the control signal.” Claim 40 recites “the encoder circuit producing the plurality of first symbols at the first output terminal and the transform of the plurality of first symbols at the second output terminal in response to a first value of the control signal, the encoder circuit producing the plurality of first symbols at the first output terminal and not producing the transform of the plurality of first symbols at the second output terminal in response to a second value of the control signal.” (emphasis added). These features of the claimed invention are described in detail at paragraphs 28-29 of U.S. Pub. No. 2004/0101032.

Examiner offers no rational reason why one of ordinary skill in the art at the time of the present invention would think to combine the transmit diversity scheme of Whinnett et al. with the power control scheme of Secord et al. to produce the present invention. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). (MPEP § 2142). Examiner has failed to establish a *prima facie* case of obviousness. Thus, claims 28 and 40 and their respective depending claims are patentable under 35 U.S.C. § 103(a) over the cited references.

Moreover, a *prima facie* obviousness case requires a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner identifies the top line of 88 (Figure 5, Whinnett et al.) as the plurality of symbols at the first output terminal and the bottom line of 88 as the transform of the plurality of symbols at the second output terminal. Regarding the disclosure of Secord et al., Examiner states "power control bits which transforms the signal are only inserted depending on the output signal of MUX 40 in Fig. 5." Examiner identifies unrelated excerpts from each reference, but fails to offer a coherent explanation of how they might be combined to produce the claimed invention. Does Examiner contend that one of ordinary skill in the art would decide to transmit the top and bottom lines of 88 (Whinnett et al., Figure 5) in response to the power control bits of Secord et al. and to transmit only the top line of 88 in the absence of power control bits? Such a modification would certainly defeat the purpose of Whinnett et al. Alternatively, is Examiner changing what was previously identified as the transform of the plurality of symbols at the second output terminal? Is the transform of the symbols now the presence of power control bits in the data stream? If so, the transform is not a transform of the plurality of symbols at the first output terminal. Applicants respectfully request clarification. The present rejection based on an improper combination of Whinnett et al. with Secord et al. makes no sense.

Finally, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Examiner identifies the output terminals of 88 (Figure 5) of Whinnett et al. as first and second output terminals. Examiner states that power control bits of Secord et al. transform the output of MUX 40 in Figure 5. Regarding the disclosure of Secord et al., if operation of the power control bits causes a transform of the signals, then either the signals or the transform of the signals is produced. Secord et al. do not teach that both are produced. Alternatively, if there are power

RECEIVED
CENTRAL FAX CENTER

AUG 07 2008

control bits for one position of the MUX 40 and no power control bits for another position of MUX 40, then the signals are different for different positions of MUX 40. The transformed signals at the second output terminal, therefore, are not transformations of the signals at the first output terminal. Moreover, Examiner fails to state how any combination of power control bits might be used to determine which signals of 88 are transmitted and which are not. Therefore, the foregoing emphasized limitations of claims 28 and 40 are simply not present. Thus, claims 28 and 40 and their respective depending claims are patentable under 35 U.S.C. § 103(a) over the cited references.

In view of the foregoing, applicants respectfully request reconsideration and allowance of claims 28, 30-35, 39-42, and 44-49. If the Examiner finds any issue that is unresolved, please call applicants' attorney by dialing the telephone number printed below.

Respectfully submitted,



Robert N. Rountree
Attorney for Applicants
Reg. No. 39,347

Robert N. Rountree, LLC
70360 Highway 69
Cotopaxi, CO 81223
Phone/Fax: (719) 783-0990